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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,496	08/06/2001	David Ineson	01831058	2288

24500 7590 11/18/2003

SIEMENS CORPORATION  
INTELLECTUAL PROPERTY LAW DEPARTMENT  
170 WOOD AVENUE SOUTH  
ISELIN, NJ 08830

EXAMINER

NORRIS, JEREMY C

ART UNIT	PAPER NUMBER
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2827

DATE MAILED: 11/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/923,496	INESON ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jeremy C. Norris	2827	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 March 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-16,18-44 and 46-70 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 30-42 is/are allowed.
- 6) ☒ Claim(s) 1,6-8,11,43,44,47,48,54-56,59 and 64-66 is/are rejected.
- 7) ☒ Claim(s) 4,5,9,10,12-15,46,49-53,57,58,60-63 and 67-70 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 October 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 8, 11, 43, 44, 47, 48, 56, 59, and 64-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,321,444 (hereafter Yatsuda) in view of US 5,218,234 (hereafter Thompson).

Yatsuda discloses, referring to figure 1, a surface mount electrical component assembly comprising: a retainer comprising a retaining base having an opening (12e) and an annular collar (12) around said opening; an electrical component (10) retained in the annular collar of said retainer, said electrical component having a plurality of electrical leads (14) thereon a plurality of conductive ends (12a) connected to the

bottom of said retaining base said conductive ends adapted to receive said electrical leads for electrical connection to said electrical component. Yatsuda does not specifically state that the plurality of conductive ends comprise conductive pads [claims 1, 43, 44, 47, 48, 64, 65]. However, it is well known in the art to use pads as conductive means to connect bumped components to electrical substrates as evidenced by Thompson (see figure 2, and the corresponding discussion in col. 3, lines 15-30). Therefore, it would have been obvious, to one having ordinary skill in the art, at the time of invention, to comprise the conductive ends of Yatsuda of conductive pads as is well known in the art and evidenced by Thompson. The motivation for doing so would have been to employ a well-known technique to ensure a reliable electromechanical connection, thus making the device more reliable.

Additionally, the modified invention of Yatsuda includes means (12c) for enhancing retention of the electrical component in said annular collar [claims 8, 56], wherein the conductive ends are molded to the retaining base [claims 11, 59], wherein the retaining body comprises a cylindrical portion around the opening having a closed top end (12c) opposite the opening [claim 66].

Claims 6, 7, 54, and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yatsuda in view of Thompson as applied to claim 1 above, and further in view of US 5,802,699 (hereafter Fjelstad).

Yatsuda, as modified by Thompson above with respect to claim 1, discloses the claimed invention except the modified invention of Yatsuda does not

specifically state that the annular collar is made of a stiff resilient insulator [claims 6, 54] which comprises rubber [claims 7, 55]. However, Fjelstad teaches forming annular retaining collars of stiff resilient insulating materials (see figure 17 and col. 21, lines 25-55) of which rubber is one such well known material. Therefore, it would have been obvious, to one having ordinary skill in the art, at the time of invention, to use rubber as the material for the annular collar in the invention of Yatsuda in view of Thompson. The motivation for doing so would have been to employ a well known material to mechanically protect the circuit device. Moreover, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

#### ***Response to Arguments***

Applicant's arguments with respect to claims 1, 6-8, 11, 43, 44, 47, 48, 54-56, 59, and 64-66 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Allowable Subject Matter***

Claims 30-42 are allowed.

Claims 4, 5, 9, 10, 12-15, 46, 49-53, 57, 58, 60-63, and 67-70 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The indicated allowability of claims 2, 3, 6, 7, 8, 45, 54, 55, and 66 is withdrawn in view of the newly discovered reference(s). Rejections based on the newly cited reference(s) are stated above.

**Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 5,102,829	Cohn,
US 5,454,160	Nickel,
US 6,217,349	Konno.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy C. Norris whose telephone number is 703-306-5737. The examiner can normally be reached on Tuesday - Friday, 10am - 7pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kamand Cuneo can be reached on 703-308-1233. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

JCSN

*David A. Zander*  
David A. Zander  
Primary Examiner 09/2827  
11/2/3